

**REMARKS**

In the Office Action, the Examiner objected to the drawings. Enclosed herewith is an amended drawing Figure 1 marked as "Replacement Sheet" in conformity with 37 C.F.R. 1.121(d) and 1.84(c).

In the Office Action, the Examiner rejected claims 1 - 8, all of the pending claims, under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (AAPA) in view of Riedl (U.S. Patent 4,706,936) and Scott, et al., (U.S. Patent 3,014,494).

"Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by an examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *Ex parte Gottling*, (B. P. A.I. 2005) (unpublished); *KSR v. Teleflex*, (Fed. Cir. 04-1152, January 6, 2005).

The Examiner has opined that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the steps of Reidi (sic) and the steps of Scot (sic) et al. on the method of AAPA so as to quickly fulfill the work with accuracy." [office action, page 3, lines 20 - 22].

Neither Reidl nor Scott, et al., specifically recognize the

advantages discussed in Applicant's application, namely safety and specifically quantified time savings [4 seconds] **during pit stop intervals of automobile racing**. [Application, page 4, lines 5 - 25; page 5, line 25 through page 6, line 12; and page 6, line 25 through page 7, line 22]. See, e.g., *In re Nomiya, et al.*, 184 U.S.P.Q. 607, 612 - 613 (CCPA 1975). Reidl discloses a manual crank assembly suitable for "large containers lifted from the loading surface of a truck" [Reidl, column 1, line 23 through column 3, line 36; column 4, lines 23 - 35] which by its very nature would have little or no application or advantage in pit stop environments of automobile racing where seconds and split-second timing count heavily towards the difference between winning or losing during racing. Similarly, the tool mount taught by Scott, et al., provides an "overhead rail carrying for movement along it a trolley from which is suspended a vertical support provided with a boom" intended for large areas of operation within an industrial regions [Scott, et al., column 1, lines 31 - 49] and it, too, has no practical application to pit stop environments of automobile racing. The courts have consistently held that consideration must be given "where the references diverge and teach away from the claimed invention." *Akzo N.V. v. International Trade Commission*, 1 U.S.P.Q. 2<sup>ND</sup> 1241, 1246 (Fed. Cir. 1986).

Further, neither Reidl nor Scott, et al., suggest using manual

passing of implements from one operator to the other absent use of the specific mechanical means which are the subject of the respective disclosure and claims of those references. Since neither reference suggests the desirability of the modification of Applicant's invention, rejection based upon 35 U.S.C. §103 cannot be sustained. *In re Fritch*, 23 U.S.P.Q. 2<sup>ND</sup> 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Even if the references are combined in the manner proposed by the Examiner (which Applicant respectfully submits is improper as discussed above), the resulting method would not realize the advantages or benefits of the claimed invention. Applicant's disclosed and claimed invention, taken as a whole, traverses any possible *prima facie* case of obviousness cited by the Examiner in either of the references, or their combination. *In re Wright*, 6 U.S.P.Q. 2<sup>ND</sup> 1959, 1962 (Fed. Cir. 1988). Applicant's invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problems it solves. *Id.*, at 1961. Accordingly, rejection of pending claims 1 - 8 under 35 U.S.C. §103(a) is misplaced.

With the filing of this response, the application and all claims should be in condition for allowance. Notification of the allowance of this application is respectfully solicited.

For all the reasons advanced above, Applicant respectfully

submits that the application is in condition for allowance and requests reconsideration of the same. That action is earnestly solicited.

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Respectfully submitted,  
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Enclosures: Drawing Figures 1 - 3/ - "Replacement Sheet" [1 page]  
 Form PTO/SB/21 [1 page]  
 Facsimile Coversheet [1 page]

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/Charles L. Thoeming/  
 Charles L. Thoeming, Registered  
 Representative of Applicants  
September 26, 2005  
 Date of Signature